## REMARKS/ARGUMENTS

***Status of Claims***

Claims 1-54 and 63-73 are pending in the application.

Claims 55-62 are withdrawn from consideration.

Claims 1, 23-30, 33, 43, 45, 46, 54, 63, and 69 are hereby amended.

Claims 19 and 53 are hereby canceled.

Claims 74 and 75 are new.

Applicants hereby request further examination and reconsideration of the presently claimed application.

***Response to Restriction Requirement***

The Applicant would like the Examiner to confirm that claims 1-54 and 63-73 are currently pending before the Examiner, not claims 1-52 and 63-73 as identified in the office action.

***Allowable Subject Matter***

Applicant notes with appreciation the indication that claims 9-18, 20, 22, and 30 would be allowable if rewritten in independent form.

***Unexamined Claims***

It does not appear that the Examiner examined claim 54 as it was objected to, but neither allowed nor rejected. The applicants respectfully request clarification regarding claim 54.

***Specification Amendments***

The specification has been amended to include the serial number of the application identified in paragraph [0001] of the application. No new matter is contained in this amendment.

***Claim Objections***

Claims 23-30, 43, 45, 46, and 54 have been amended to correct the antecedent bases identified by the Examiner.

***Claim Rejections – 35 USC § 112***

In order to overcome the Examiner's rejections, claims 19 and 53 have been canceled.

***Claim Rejections – 35 USC § 102***

The Examiner rejected claims 1-4, 21, 23, 25-27, 31, 33, 34, 38, 41, 49, and 53 under 35 USC § 102(b) as being anticipated by *Hsueh* (U.S. 4,696,345). The Examiner also rejected claims 1-6, 21, 23-31, 33, 41, 42, 44-52, 63-66, 69-71, and 73 under 35 USC § 102(b) as being anticipated by *Vandergrift* (U.S. 4,099,570). As explained by the Court of Appeals for the Federal Circuit: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Amended claim 1 reads:

> 1. A method of servicing a wellbore, comprising: using a loop system to heat oil in a subterranean formation contacted by the wellbore, wherein the loop system conveys steam down the wellbore; **wherein the heat reduces the viscosity of the oil, thereby allowing the oil to flow by natural forces into a second wellbore.**

Amended claims 33, 63, and 69 contain similar limitations. Neither *Hsueh* nor *Vandergrift* teach the limitation that heat reduces the viscosity of the oil, thereby allowing the oil to flow by natural forces to a second wellbore. *Hsueh* teaches that a driving fluid creates an artificial pressure gradient using an injection well and that the oil flows along the artificial pressure gradient to the production well. Flow due to an artificial pressure gradient is not the same as flow due to natural forces. *Vandergrift* teaches that steam is injected into a wellbore to heat the surrounding formation, and that the heated oil flows back into the same wellbore, i.e. the steam injection wellbore, **not** a second wellbore. Thus, neither *Hsueh* nor *Vandergrift* teach the limitation that heat

reduces the viscosity of the oil, thereby allowing the oil to flow by natural forces to a second wellbore. By failing to teach each and every limitation of the claims, *Hsueh* and *Vandergrift* fail to anticipate claims 1, 33, 63, and 69, and thus claims 1, 33, 63, and 69 should be allowed over *Hsueh* and *Vandergrift*. Claims 2-6, 21, 23-31, 34, 38, 41, 42, 44-53, 64-66, 70, 71, and 73 depend on claims 1, 33, 63, and 69 and thus are also allowable over *Hsueh* and *Vandergrift*.

***Claim Rejections – 35 USC § 103***

The Examiner rejected claims 6-8 under 35 USC § 103(a) as being unpatentable over *Vandergrift* in view of *Sanchez* (U.S. 5,148,869). The Examiner rejected claim 32 under 35 USC § 103(a) as being unpatentable over *Vandergrift* in view of *Rogers* (U.S. 5,148,869) or *Rivas* (U.S. 4,678,039). The Examiner rejected claims 34-40 and 43 under 35 USC § 103(a) as being unpatentable over *Vandergrift* in view of *Gregoli* (U.S. 6,016,868) or *Young* (U.S. 3,809,159). The Examiner rejected claims 67, 68, and 72 under 35 USC § 103(a) as being unpatentable over *Vandergrift* in view of *Sheinbaum* (U.S. 4,364,232). Thus, claims 6-8, 32, 34-40, 43, 67, 68, and 72 stand or fall on the application of *Vandergrift* to the claims.

The requirements for establishing a *prima facie* case of obviousness are well established:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the § 102(b) rejections above, *Vandergrift* fails to teach or suggest the limitations contained in amended claims 1, 33, 63, and 69. In addition, all dependent claims incorporate the limitations of the claims they depend on. Because claims 6-8, 32, 34-40, 43,

67, 68, and 72 depend on and therefore incorporate the limitations of amended claims 1, 33, 63, and 69 and *Vandergrift* fails to teach the limitations of amended claims 1, 33, 63, and 69, *Vandergrift* also fails to teach or suggest the limitations contained in claims 6-8, 32, 34-40, 43, 67, 68, and 72. The Examiner does not cite the remaining prior art references to teach the limitations that are absent from *Vandergrift*. Thus, the Examiner has not established a *prima facie* case of obviousness as to claims 6-8, 32, 34-40, 43, 67, 68, and 72, which are allowable over the cited prior art.

***New Claims***

New claims 74 and 75 have been added to further define the invention. More particularly, the new claims focus on gravity being the natural force. New claims 74 and 75 are novel and non-obvious over the cited prior art because they depend on allowable independent claims. No new matter is contained in these new claims.

## CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicant. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated August 25, 2005 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: 11/18/05

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